

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: November 29, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

Rolex Watch U.S.A., Inc.

v.

PWT A/S

—
Opposition No. 91231624
—

Beth M. Frenchman and Adam Sgro of Gibney, Anthony & Flaherty, LLP,
for Rolex Watch U.S.A., Inc.

Marsha G. Gentner and Eric T. Fingerhut of Dykema Gossett PLLC,
for PWT A/S.

—
Before Bergsman, Wellington and Pologeorgis,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

PWT A/S (“Applicant”) seeks registration on the Principal Register of a crown
design reproduced below:¹



¹ Serial No. 79172020 was filed on November 27, 2014, based on a request for protection of International Registration No. 123679 registered November 27, 2014, under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a).

The mark consists of a crown design and Applicant does not claim color as a feature of the mark.

The application includes the following description of goods and services:

Toilet soaps, perfumery, namely, eau de toilette; essential oils; cosmetics; perfumed toilet preparations, namely, shampoos, facial cleanser; preparations for cleaning, care and beautification of the skin, scalp and hair; deodorizing preparations for personal use, namely, deodorants for body care, in International Class 3;

Spectacles; sunglasses; frames for glasses; lenses for eyeglasses; eyeglasses cases; bags, cases and sleeves for electronic apparatus and instruments, namely, for computers, laptops, tablets, telephones, smartphones, media players and cameras, in International Class 9;

Leather, trunks and travelling bags; all-purposes carrying bags; handbags; travelling bags, traveling sets made of leather, garment bags for travel, vanity cases not fitted, backpacks, sports bags, beach bag, shopping bags, shoulder bags, school bags, canvas bags for travelling, attache cases, boxes of leather or leather board, briefcases, bags of leather for packaging, wallets, purses, key wallets and key rings of leather not included in other classes; umbrellas, parasols, walking-sticks, walking stick seats, in International Class 18;

Clothing, namely, rainwear, ski wear, protective clothing, namely, raincoats, fur coats, coats, jackets, clothing jackets, sleeveless jackets, suits, shirts, skirts, dresses, blouses, bathrobes, dressing gowns, cardigans, sweaters, gloves, gym suits, imitation leather trousers, imitation leather skirts, imitation leather jackets, jerseys, kilts, knickerbockers, leather trousers, leather skirts, leather jackets, overalls, overcoats, parkas, plus fours, pockets for clothing, pullovers, pajamas, scarves, shawls, stoles, sashes for wear, shorts, singlets, sports jerseys, sports shirts, tailor-made suits, tops, trousers, t-shirts, sweatshirts, tunics, vests, waistcoats, rompers, ties, clothing belts, underwear, anti-perspiration underwear, girdles, slips, camisoles, half-slips, perspiration absorbing underwear, petticoats, underpants, undershirts,

underskirts, corsets, body stockings, long underwear, socks, leotards, stockings, tights, swimming suits; footwear; headwear, namely, hats, caps, kerchiefs, earmuffs, headbands, in International Class 25; and

Presentation of goods on communication media for retail purposes in the form of advertising; assistance in management of business activities; marketing services; wholesale and retail store services, including via the Internet, featuring toilet soaps, perfumery, essential oils, cosmetics, perfumed toilet preparations, preparations for cleaning, care and beatification of the skin, scalp and hair, deodorizing preparations for personal use, spectacles, sunglasses, frames for glasses, lenses for eyeglasses, glasses cases, bags, cases and sleeves for electronic apparatus and instruments, including for computers, laptops, tablets, telephones, smartphones, media players and cameras, leather and goods made thereof, trunks and travelling bags, bags and handbags, travelling bags, travelling sets, garment bags for travel, vanity cases, backpacks, sports bags, beach bags, shopping bags, shoulder bags, school bags, canvas travelling sack, attache cases, boxes of leather or leather board, briefcases, bags of leather for packaging, wallets, purses, key purses, clothing, namely, casual clothing, athletic clothing, exercise clothing, rainwear, golf wear, ski wear, protective clothing, namely, raincoats, fur coats, coats, jackets, clothing jackets, sleeveless jackets, suits, shirts, skirts, dresses, blouses, bathrobes, dressing gowns, cardigans, sweaters, formal wear for men, gloves, gym suits, imitation leather trousers, imitation leather skirts, imitation leather jackets, jerseys, kilts, knickerbockers, leather trousers, leather skirts, leather jackets, overalls, overcoats, parkas, plus fours, pockets for garments, pullovers, pajamas, scarves, shawls, stoles, sashes for wear, shorts, singlets, sports jerseys, sports shirts, tailor-made suits, tops, trousers, t-shirts, sweatshirts, tunics, vests, waistcoats, rompers, ties, clothing belts, underwear, anti-perspiration underwear, girdles, slips, camisoles, half-slips, perspiration absorbing underwear, petticoats, underpants, undershirts, underskirts, corsets, body stockings, long underwear, socks, leotards, stockings, tights, swimming suits, footwear, headwear, namely, hats, caps, kerchiefs, earmuffs, headbands, in International Class 35.

Rolex Watch U.S.A., Inc. (“Opposer”) filed a Notice of Opposition against the registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) as to all classes.² Opposer claims ownership of the registered mark described as a crown design with five points for “time pieces of all kinds and parts thereof,” in International Class 14,³ and “retail store services featuring watches, timepieces, clocks and jewelry,” in International Class 35.⁴ We reproduce below the registered crown design:



Applicant, in its Answer, denied the salient allegations of the Notice of Opposition. Applicant also alleged, “Opposer is barred by the doctrine of laches, acquiescence, legal and equitable estoppel from bringing and maintaining the present cancellation [sic] claims.”⁵

² Opposer also alleged dilution under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), and “a false association, affiliation or connection as to the origin of Applicant’s mark in violation of Section 43(a) of the Trademark Act, 15 U.S.C. § 1125(a).” However, inasmuch as Opposer did not pursue these claims at trial or argue them in its brief, Opposer has waived them. *See Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013, *aff’d*, 565 F. App’x (Fed. Cir. 2014) (mem.); *Swatch AG (Swatch SA) (Swatch Ltd.) v. M.Z. Berger & Co.*, 108 USPQ2d 1463, 1465 n.3 (TTAB 2013), *aff’d*, 787 F.3d 1368, 114 USPQ2d 1892 (Fed. Cir. 2015).

³ Registration No. 0657756, registered January 28, 1958; fourth renewal.

⁴ Registration No. 4458524, registered December 31, 2013; Sections 8 and 15 declarations accepted and acknowledged.

⁵ 4 TTABVUE 3.

I. Preliminary Issue

- A. Applicant's motion for leave to amend its Answer to add a counterclaim for partial cancellation of Registration No. 0657756.

On March 18, 2019, Applicant filed a motion for leave to amend its Answer to assert a counterclaim for partial cancellation under Section 18 of the Trademark Act, 15 U.S.C. § 1068. Specifically, Applicant seeks to restrict Opposer's description of goods from "timepieces of all kinds and part thereof" to "timepieces of all kinds and parts thereof **sold and/or offered for sale in jewelry stores.**"⁶

The Board denied Applicant's motion for leave to amend because "Applicant has failed to assert any allegations demonstrating how the proposed restriction would serve to avoid a likelihood of confusion."⁷ The Board explained that such allegations are necessary to provide Opposer with fair notice of the restriction sought and properly to frame the issue for trial.⁸ The Board allowed Applicant time to serve a second amended answer and counterclaim for partial cancellation if Applicant has a basis for doing so.⁹

On September 24, 2019, Applicant filed a "Second Amended Answer to Notice of Opposition and Counterclaim for Partial Cancellation under Trademark Act, §18."¹⁰ On October 23, 2019, Opposer moved to dismiss Applicant's second amended answer

⁶ 26 TTABVUE 2.

⁷ 27 TTABVUE 7.

⁸ *Id.*

⁹ *Id.* at TTABVUE 8.

¹⁰ 32 TTABVUE.

and counterclaim.¹¹ The Board denied Applicant's second motion for leave to file an amended answer and counterclaim because, inter alia, the proposed counterclaim did not include a corresponding restriction to Applicant's description of goods and services and, therefore, the parties could offer their goods and services in overlapping channels of trade.¹²

Applicant, in its brief, argues that the Board should not have denied its motion for leave to file a counterclaim under Section 18 of the Trademark Act.¹³ In other words, Applicant seeks reconsideration of the Board's decision more than one year after the Board denied Applicant's motion for leave to amend its answer to add a counterclaim. *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Manufacturing Co.*, 55 USPQ2d 1848, 1854 (TTAB 2000) (applicant's "reformation" of Board's earlier order treated as a motion for reconsideration because it requests a modification of the previous order – "Applicant's attorney's mis-captioning of the motion for reconsideration as a motion for 'reformation' is clearly an attempt to avoid the obvious requirements of the correct rule, and is another indication of bad faith.").

Any request for reconsideration or modification of an order or decision issued on a motion must be filed within one month from the date thereof. A brief in response must be filed within twenty days from the date of the service of the request.

Trademark Rule 2.127(b), 37 C.F.R. § 2.127(b). *See also U.S. Olympic Comm. v. Tempting Brands Netherlands B.V.*, 2021 USPQ2d 164, at *6 (TTAB 2021)

¹¹ 33 TTABVUE.

¹² 36 TTABVUE 4-6.

¹³ Applicant's Brief, pp. 7-11 (71 TTABVUE 14-18).

(applicant's request in its trial brief that the Board reconsider previously issued interlocutory orders denied as untimely).

We decline to reconsider the order or take any other action regarding Applicant's motion for leave to add a counterclaim for partial cancellation because Applicant is seeking an untimely review of the Board's previous order. In reaching this decision, we note that were we to grant Applicant's request at this late date, we would have to reopen trial and briefing because Opposer did not have notice that it would have to defend against the counterclaim.

II. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Applicant's application. The parties introduced the testimony and evidence listed below:

A. Opposer's Testimony and Evidence.

1. Testimony declaration of E. Deborah Jay, principal and founder of Jay Survey Strategics LLC, a California research firm specializing in marketing and public opinion surveys;¹⁴
2. Notice of reliance on Applicant's response to Opposer's first set of interrogatories;¹⁵

¹⁴ 40 TTABVUE.

¹⁵ 41 TTABVUE 5-13.

3. Notice of reliance on Applicant's supplemental response to Opposer's interrogatory No. 16;¹⁶
4. Notice of reliance on Applicant's response to Opposer's second set of interrogatories;¹⁷
5. Notice of reliance on Applicant's supplemental responses to Opposer's second set of interrogatories;¹⁸
6. Notice of reliance on USPTO and court records purportedly to show Opposer's policing efforts to protect its crown design mark;¹⁹
7. Notice of reliance on Internet documents purportedly to show Applicant's goods and services are related to Opposer's goods and services;²⁰
8. Notice of reliance on printed publications and Internet news articles purportedly to show Applicant's goods and services are related to Opposer's goods and services;²¹
9. Notice of reliance on Internet documents purportedly to show the manner in which Applicant uses its crown mark;²²

¹⁶ *Id.* at15-17.

¹⁷ *Id.* at19-22.

¹⁸ *Id.* at24-27.

¹⁹ 42 TTABVUE.

²⁰ 43 TTABVUE 7-198.

²¹ 43 TTABVUE 200-233.

²² 44 TTABVUE 7-74.

10. Notice of reliance on Internet documents purportedly to show that the parties offer their goods and services in the same channels of trade;²³
11. Notice of reliance on copies of news articles in printed publications purportedly to show the strength of Opposer's mark;²⁴
12. Notice of reliance on Internet documents purportedly to show the strength of Opposer's mark;²⁵
13. Testimony declaration of Marc Esposito, Opposer's Vice President of Services Operations;²⁶
14. Notice of reliance on Internet documents purportedly to show the strength of Opposer's mark;²⁷
15. Rebuttal declaration of E. Deborah Jay;²⁸
16. Rebuttal notice of reliance on the full text of Opposer's responses to Applicant's written discovery to which Applicant introduced partial responses;²⁹

²³ 44 TTABVUE 76-391.

²⁴ 45 TTABVUE 9-65.

²⁵ *Id.* at 67-289.

²⁶ 46-47 TTABVUE. The Board posted the portions of the Esposito declaration Opposer designated confidential at 48 TTABVUE.

²⁷ 49 TTABVUE.

²⁸ 62 TTABVUE.

²⁹ 63 TTABVUE.

17. Rebuttal notice of reliance on Internet documents in response to Applicant's testimony regarding "street tailoring";³⁰
18. Rebuttal notice of reliance on Internet documents purportedly to show the parties offer their goods and services in the same channels of trade;³¹
19. Rebuttal notice of reliance on Internet documents purportedly to show the strength of Opposer's mark;³² and
20. Rebuttal testimony declaration of Marc Esposito.³³

B. Applicant's Testimony and Evidence.

1. Notice of reliance on Opposer's supplemental responses to Applicant's first set of interrogatories;³⁴
2. Notice of reliance on Opposer's responses to Applicant's request for production of documents;³⁵

³⁰ 64 TTABVUE 7-174.

³¹ *Id.* at 176-187.

³² *Id.* at 189.

³³ 65 TTABVUE.

³⁴ 52 TTABVUE 3-18.

³⁵ *Id.* at 20-27. Generally, responses to a request for production of documents introduced through a notice of reliance are admissible solely for purposes of showing that a party has stated that there are no responsive documents; documents produced in response to the requests are generally not admissible by notice of reliance alone. Trademark Rule 2.120(j)(3)(ii), 37 C.F.R. § 2.120(j)(3)(ii); *see also City Nat'l Bank v. OPGI Mgmt. GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1674 n.10 (TTAB 2013) (responses to document production requests are admissible solely for purposes of showing that a party has stated that there are no responsive documents); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036 n.7 (TTAB 2012) (written responses to document requests indicating that no documents exist may be submitted by notice of reliance). Accordingly, we consider Opposer's responses only for the limited purpose of showing that Opposer did not have any responsive documents.

3. Notice of reliance on Opposer's responses to Applicant's requests for admission;³⁶
4. Testimony declaration of Kenneth Hollander, Principal of Kenneth Hollander Associates, a market research firm;³⁷
5. Notice of reliance on Internet documents purportedly to show the parties offer their goods and services in different channels of trade;³⁸
6. Notice of reliance copies on Internet documents purportedly to show that crown symbols have a meaning in connection with watches;³⁹
7. Notice of reliance on Internet documents purportedly showing third parties using crown designs in connection with jewelry, watches and retail stores;⁴⁰
8. Notice of reliance on third-party registrations consisting of crown designs purportedly to show that crown designs are weak marks;⁴¹

³⁶ 52 TTABVUE 29-35.

³⁷ 53 TTABVUE.

³⁸ 54 TTABVUE.

³⁹ 55 TTABVUE.

⁴⁰ 56 TTABVUE.

⁴¹ 57 TTABVUE. We do not consider pending applications because they are evidence only that the applicants filed them on a certain date; they are not evidence of use of the marks. *Nike Inc. v. WNBA Enters. LLC*, 85 USPQ2d 1187, 1193 n.8 (TTAB 2007); *Interpayment Services Ltd. v. Docters & Thiede*, 66 USPQ2d 1463, 1468 n.6 (TTAB 2003); *Olin Corp. v. Hydrotreat, Inc.*, 210 USPQ 62, 65 n.5 (TTAB 1981).

In addition, we do not consider registrations registered under Sections 44 or 66 of the Trademark Act unless the registrants filed a Section 8 or 71 declaration of use because the registrants do not base their Sections 44 or 66 registrations on use.

We do not consider the Kansas City Royals logo (Registration No. 1522388) (57 TTABVUE 69-70) or the MASERATI logo (Registration Nos. 4726268, 1212375, and 1315200) (57

9. Testimony declaration of Ole Koch Hansen, Applicant’s Chief Executive Officer;⁴²

10. Notice of reliance on Internet documents purportedly showing the descriptive significance of crowns in connection with jewelry;⁴³ and

11. Notice of reliance on dictionary definitions of “timepiece,” “feature,” and “featuring.”⁴⁴

III. Entitlement to a Statutory Cause of Action⁴⁵

Entitlement to a statutory cause of action, formerly referred to as “standing” by the Federal Circuit and the Board, is an element of the plaintiff’s case in every inter partes case. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277 (Fed. Cir. 2020), *cert. denied*, ___ S. Ct. ___ (2021); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 (Fed. Cir. 2020), *reh’g en banc denied* 981 F.3d 1083, 2020 USPQ2d 11438 (Fed. Cir. 2020), *r cert. denied*, __ S.Ct. __, 2021 WL 4507693 (2021); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest

TTABVUE 125-130) because they are used to identify collateral merchandise on souvenir items to show support for the third-parties’ core business.

⁴² 58 TTABVUE. The Board posted the portions of the Hansen declaration Applicant designated confidential at 59 TTABVUE.

⁴³ 60 TTABVUE.

⁴⁴ 61 TTABVUE.

⁴⁵ Even though we now refer to standing as entitlement to a statutory cause of action, our prior decisions and those of the Federal Circuit interpreting “standing” under §§ 1063 and 1064 remain applicable. *See Spanishtown Enters., Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020).

falling within the zone of interests protected by the statute and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *Corcamore*, 2020 USPQ2d 11277 at *4. See also *Empresa Cubana*, 111 USPQ2d at 1062; *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (TTAB 1982); *Spanishtown Enters.*, 2020 USPQ2d 11388, at *1.

Marc Esposito, Opposer's Vice President, Service Operations, introduced certified copies of Opposer's Registration No. 0657756 (certified July 16, 2018, two years and five months before Opposer introduced it into evidence) and Registration No. 4458524 (certified August 1, 2016, four years and four months before Opposer introduced it into evidence).⁴⁶ Esposito testified that the certified copies are "true and genuine copies" of Opposer's pleaded registrations and that the registrations "are in full force and effect."⁴⁷ Esposito's testimony is sufficient to prove the status and title of the registrations.⁴⁸

⁴⁶ Esposito Testimony Decl. Exhibit 2 (46 TTABVUE 159-161 and 164-166). Mr. Esposito also introduced a certified copy of Registration No. 1755226 for the crown mark for "jewelry," in International Class 14. *Id.* at TSDR 162-163. However, because Opposer did not plead ownership of this registration in its Notice of Opposition, we do not consider it.

⁴⁷ Esposito Testimony Decl. ¶6 (46 TTABVUE 3-4).

⁴⁸ The certified copies alone without Mr. Esposito's testimony are not sufficient to establish the status of and title to the registrations because their certification as to status and title is not contemporaneous with their introduction into evidence. See *Sterling Jewelers Inc. v. Romance & Co.*, 110 USPQ2d 1598, 1601 n.2 (TTAB 2014) (plain copy of registration attached to notice of opposition indicating issuance five years before such filing not "reasonably contemporaneous"); *Hard Rock Café Int'l (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1511 (TTAB 2000) (status and title copies prepared three years prior to opposition not reasonably contemporaneous); *Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487, 1488 n.3 (TTAB 1990) (status and title copies from 1963 not reasonably contemporaneous with filing of opposition in 1986).

Because Opposer has properly introduced into evidence copies of its pleaded registrations showing the status of and title thereof, Opposer has established its entitlement to a statutory cause of action. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Primrose Ret. Cmtys.*, 122 USPQ2d at 1032 (standing established based on pleaded registration made of record).

IV. Priority

Because Opposer has properly made of record copies of its pleaded registrations, priority is not an issue as to the mark and the goods and services covered by the registrations. *See Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1469 (TTAB 2016) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d. 1400, 182 USPQ 108, 110 (CCPA 1974)).

V. Likelihood of Confusion

We base our determination under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *DuPont*, 177 USPQ at 567 (cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015)); *see also Majestic Distilling Co.*, 65 USPQ2d at 1203. “In discharging this duty, the thirteen *DuPont* factors ‘must be considered’ ‘when [they] are of record.’” *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) and *DuPont*, 177 USPQ at 567). “Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. Any single factor may control a particular case.”

Stratus Networks, Inc. v. UBTA-UBET Commc'ns Inc., 955 F.3d 994, 2020 USPQ2d 10341, *3 (Fed. Cir. 2020) (citing *Dixie Rests.*, 41 USPQ2d at 1406-07).

“Each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). *See also In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int’l v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

A. Strength of Opposer’s mark

In determining the strength of a mark, we consider both its inherent strength, based on the nature of the mark itself, and its commercial strength, based on the marketplace recognition value of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning.”); *Top Tobacco, L.P. v. N. Atl. Operating Co., Inc.*,

101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006); 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:80 (5th ed. 2021) (“The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”). Market strength is the extent to which the relevant public recognizes a mark as denoting a single source. *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d at 1899. In other words, it is similar to acquired distinctiveness.

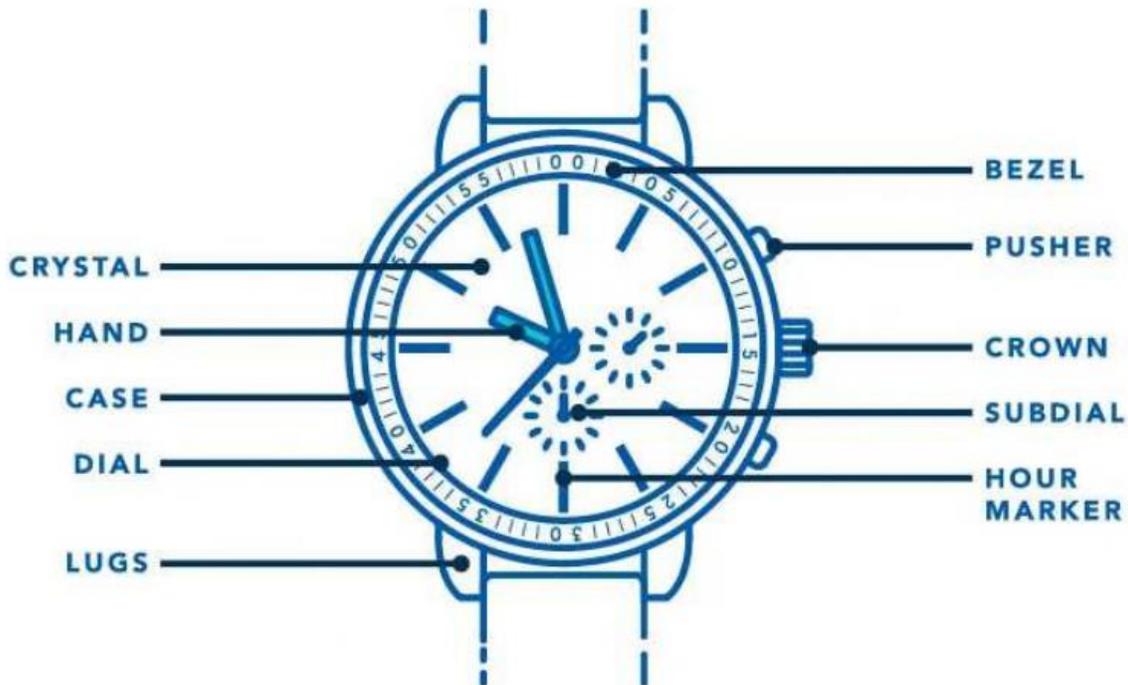
For purposes of analysis of likelihood of confusion, a mark’s renown may “var[y] along a spectrum from very strong to very weak.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (internal quotations omitted). The proper standard is the mark’s “renown within a specific product market,” *id.*, and “is determined from the viewpoint of consumers of like products,” *id.* at 1735, and not from the viewpoint of the general public.

1. Inherent strength

Because Opposer’s mark is registered on the Principal Register, with no claim of acquired distinctiveness under Section 2(f), we presume it is inherently distinctive and, at worst, is suggestive of Opposer’s goods and services. 15 U.S.C. § 1057(b) (registration is “prima facie evidence of the validity of the registered mark”); *In re Fiesta Palms, LLC*, 85 USPQ2d 1360, 1363 (TTAB 2007) (when mark is registered on the Principal Register, “we must assume that it is at least suggestive”).

Applicant contends, “[a] crown or crown design is hardly arbitrary with respect to watches.”⁴⁹ To prove its contention, Applicant introduces evidence showing that a crown is a watch part.

• The Jewelry Box Blog (jewelersmutual.com/the-jewelry-box/) presents “10 Parts of a Watch You Should Actually Know” featuring the drawing reproduced below:⁵⁰



• PrestigeTime.com (watch terminology) defines “crown” as follows:

The grooved knob on the outside case, used for setting the hands on a watch, and the day and date, where applicable. It is also used for winding the mainspring of a mechanical watch. The crown is also known as a winder or winding stem.⁵¹

⁴⁹ Applicant’s Brief, p. 24 (71 TTABVUE 31).

⁵⁰ 55 TTABVUE 31.

⁵¹ 55 TTABVUE 8.

- Esslinger.com reports the following:

Watch crowns are a necessary, and very important, part of a watch. The most common functions of a watch crown are to allow you to change the time, to change the date, to wind the watch, and to stop the watch (to extend battery life). There are many types of watch crowns that you can get to replace your watch crown and they have a variety of different features.⁵²

Applicant also introduced copies of 7 third-party registrations with crown designs for watches or watches and jewelry, 12 third-party registrations with crown designs for jewelry (without watches listed), and 21 third-party registrations with crown designs for retail jewelry stores services “to show that a crown design or mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of goods or services, and Opposer’s pleaded mark is weak and non-distinctive, and should be confined in scope or protection.”⁵³

We may use third-party registrations in the manner of a dictionary definition to illustrate how others may perceive in the trade or industry. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987) (“Said third party registrations are of use only if they tend to demonstrate that a mark or a portion thereof is suggestive or descriptive of certain goods and hence is entitled to a narrow scope of protection. Used in this limited manner, ‘third party registrations are similar to dictionaries showing how language is generally used.’”) (Internal citation omitted.) “Such third party registrations show the sense in which the word is used in ordinary parlance and may

⁵² *Id.* at 21.

⁵³ 57 TTABVUE 2 and 7-130.

show that a particular term has descriptive significance as applied to certain goods or services.” *Institut National Des Appellations D’Origine v. Vintners International Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992) (third-party registrations found to be “persuasive evidence”). *See also Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) (third-party registrations are relevant to prove that some segment of a mark has a normally understood and well-recognized meaning).

The third-party registrations introduced by Applicant are not evidence that those marks have been used at all, let alone used so extensively that consumers have become sufficiently conditioned by their usage that they can distinguish between such marks on the bases of minute differences. The probative value of third-party trademarks depends entirely upon their usage. *E.g., Scarves by Vera, Inc. v. Todo Imports, Ltd.*, 544 F.2d 1167, 192 USPQ 289, 294 (2d Cir. 1976) (“The significance of third-party trademarks depends wholly upon their usage. Defendant introduced no evidence that these trademarks were actually used by third parties, that they were well promoted or that they were recognized by consumers.”). As the Court pointed out in *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406, 407 (C.C.P.A. 1967), “the existence of these registrations is not evidence of what happens in the market place or that customers are familiar with their use.” Where, as here, the “record includes no evidence about the extent of [third-party] uses ... [t]he probative value of this evidence is thus minimal.” *See also, AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973).

While a crown is a watch part, there is no evidence consumers perceive a crown design as describing a feature of a watch. In this regard, the USPTO did not require any of the registrants to disclaim the exclusive right to use a crown design. Likewise, it is not clear how or why a crown design describes qualities or characteristics of a watch. Yet, the third-party registrations show that a watch design is desirable for use in connection with watches and jewelry. Nevertheless, because the USPTO registered Opposer's crown design on the Principal Register without a claim of acquired distinctiveness, the crown design is inherently distinctive and entitled to all the protection afforded inherently distinctive marks.

2. Commercial strength

Opposer has pleaded that its crown design “has become extremely well known and famous”⁵⁴ and, in its brief, argued that its crown design is famous.⁵⁵ Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame may be measured indirectly by the volume of sales of and advertising expenditures for the goods and services identified by the marks at issue, “the length

⁵⁴ Notice of Opposition ¶6 (1 TTABVUE 6).

⁵⁵ Opposer's Brief, pp. 17-20 and 27-31 (68 TTABVUE 25-28 and 35-39).

of time those indicia of commercial awareness have been evident,” widespread critical assessments and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d at 1305-06 and 1309. Raw numbers alone may be misleading, however. Thus, some context in which to place raw statistics may be necessary, for example, market share, sales, or advertising figures for comparable types of goods. *Id.* at 1309. Other contextual evidence probative of the renown of a mark may include the following:

- extent of catalog and direct mail advertising, email blasts, customer calls, and use of social media platforms, such as Twitter, Instagram, Pinterest, and Facebook, identifying the number of followers;

- the number of consumers that Opposer solicits through its advertising throughout the year;

- local, regional, and national radio and television advertising campaigns, free-standing print campaigns, and mentions in national publications;

- unsolicited media attention; and

- product placement in television and in movies.

Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co., 908 F.3d 1315, 128 USPQ2d 1686, 1690-91 (Fed. Cir. 2018).

Finally, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, Opposer has the duty to prove the fame of its

mark clearly. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012) (citing *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007)).

a. Jay Survey

Opposer retained E. Deborah Jay, principal and founder of Jay Survey Strategies LLC, a California research firm specializing in marketing and public opinion surveys, to conduct a survey to assess the strength, if any, of Opposer's crown design trademark.⁵⁶ She found that "the net percentage of relevant consumer who associated the Crown Design exclusively with [Opposer] in the survey was 49%."⁵⁷

The universe of survey respondents include people who have bought a watch that cost \$1,500 or more within the last two years or indicated that they would buy such a watch in the next 12 months.⁵⁸

Jay pulled the survey respondents from two companies: YouGov that maintained a panel of approximately 1.6 million adults and Survey Sampling International that maintained a panel of approximately five million adults.⁵⁹ Under Jay's supervision, YouGov hosted and administered the survey to all of the adults randomly selected from the two panels. "In all, YouGov screened 19,590 randomly selected individuals for eligibility, and only 415 (2%) qualified for the survey."⁶⁰ Of the 415 survey

⁵⁶ Jay Testimony Decl. ¶4 (40 TTABVUE 3).

⁵⁷ *Id.* at ¶18 (40 TTABVUE 7).

⁵⁸ *Id.* at ¶8 (40 TTABVUE 4).

⁵⁹ *Id.* at ¶9 (40 TTABVUE 4-5).

⁶⁰ *Id.* at ¶10 (40 TTABVUE 5).

respondents, Jay placed 211 in the test group and 2014 in the control group.⁶¹ Jay selected the test group respondents from the YouGov database and the control group respondents from the Survey Sampling International database.⁶² The test group measured the strength of Opposer's crown design and the control group measured the extent of guessing and other survey noise.⁶³

Jay showed the test group Opposer's crown design reproduced below:⁶⁴



Jay showed the control group the fictitious star design we reproduce below:⁶⁵



“In both the test and control groups, survey respondents were asked to look at the image, after which they were asked the following questions:”⁶⁶

⁶¹ *Id.* at ¶12 (40 TTABVUE 6).

⁶² Jay Test. Decl. Exhibit 1, Appendix E-1 n.1 (Image Survey Report) (40 TTABVUE 49).

⁶³ Jay Testimony Decl. ¶11 (40 TTABVUE 5).

⁶⁴ Jay Test. Decl. Exhibit 1 (Image Survey Report) (40 TTABVUE 14).

⁶⁵ *Id.*

⁶⁶ *Id.* at 40 TTABVUE 15.

(A2a) Do you associate this image with watches or jewelry made by any particular company or companies?

Yes

No

Don't know

IF YES:

(A2b) With what company or companies do you associate this image?

Before these questions were asked, the survey informed respondents that we were only interested in their opinions and beliefs, and instructed survey respondents to indicate whether they did not know the answer to a question or have an opinion or belief.⁶⁷

Over 53% of the test group survey respondents associated the crown design with watches or jewelry made by Opposer. Only 4% of the control group associated the star design with watches or jewelry made by Opposer.⁶⁸ “After subtracting the test group results from the control group results (53% less 4%), the net percentage of relevant consumers who associated the Crown Design exclusively with [Opposer] in the survey was 49%.”⁶⁹

Applicant contends, “The Jay Survey suffers from so many statistical flaws that it should be held inadmissible, let alone relied on as probative evidence to support Dr.

⁶⁷ *Id.*

⁶⁸ Jay Testimony Decl. ¶16 (40 TTABVUE 7).

⁶⁹ *Id.* at ¶18 (40 TTABVUE 7).

Jay's forgoing conclusion."⁷⁰ Applicant, in its brief, lists the following purported defects:

- "The survey did not use [Opposer's] pleaded mark to measure consumer recognition, but rather used a color version, common law mark, compared to a 'control' with a different color scheme."⁷¹ In other words, because the mark in Opposer's pleaded registrations are black and white drawings of a crown design, Jay's use of a gold crown on a green background tainted the results.

However, because the mark in Opposer's pleaded registration is a black and white drawing without a color claim, Opposer may display its crown design mark in any color or combination of colors. *See In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes*, 487 F.2d 918, 179 USPQ 729 (CCPA 1973) ("The fact that appellant's belt portion is red does not obviate the likelihood of confusion where there is no color designation for the belt portion of the reference registration."); *In re Ala. Tourism Dept.*, 2020 USPQ2d 10485, at *3 n.14 (TTAB 2020) (citing *In re Data Packaging Corp.*, 453 F.2d 1300, 172 USPQ 396, 397 (CCPA 1972) ("[T]here is no reason why an applicant should not be able to obtain a single registration of a design mark covering all different colors in which it may appear, that is to say, not limited to a particular color."); TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 807.14(e)(1) (2021) ("If a mark is initially depicted in a black-and-white special form

⁷⁰ Applicant's Brief, p. 12 (71 TTABVUE 19).

⁷¹ *Id.*

drawing in which no color is claimed, the drawing is presumed to contemplate the use of the mark in any color, without limitation.”).

However, we note that the gold crown on a green background approximates the trade dress Opposer uses in its advertising its watches using a gold crown above the name ROLEX in green.⁷² We reproduce below a representative excerpt displaying Opposer’s mark in advertising:⁷³



To the extent that the color combination may have aided survey respondents associate the crown design with Opposer, the control group should have been shown a gold star on a green background, rather than a purple background, to better account for noise or the association of the colors with Opposer. We find that the use of a different color combination with the control group stimulus may have skewed the survey results.⁷⁴

⁷² Esposito Testimony Decl. ¶15 and Exhibit 11 (46 TTABVUE 6-7 and 423-495). *See also* the media references to Opposer in the next section.

⁷³ *Id.* at 424.

⁷⁴ Dr. Jay contends the control group stimulus was an acceptable alternative because it was as attractive as the test stimulus but it did not share too many common features “to avoid having the control stimulus itself be a likely source of consumer confusion.” Jay Rebuttal Testimony Decl. ¶19 (62 TTABVUE 11). “The control group stimulus should not share the characteristic whose influence are being assessed.” *Id.* at 62 TTABVUE 11-12. However, the survey was supposed to measure the strength of the crown design, not the color combination. Jay Testimony Decl. ¶4 (40 TTABVUE 3) (“On behalf of [Opposer] my company was retained to design and conduct a survey to assess the strength, if any of [Opposer’s]  (‘Crown Design’) trademark among relevant consumers of luxury watches.”).

- “The Jay Survey’s question was leading and invited an ‘aided’ response.”⁷⁵ As noted above, Jay asked the following question: “Do you associate this image with watches or jewelry made by any particular company or companies?” According to Applicant, the non-leading form of the question is “Do you or do you not associate ...”⁷⁶

Further, the question elicited an aided response: instead of asking if the respondents associate the image with any particular company or companies, it signals the respondents that the company is one which makes “watches or jewelry.”⁷⁷

The Jay survey question is not a leading question. There is not much difference between “Do you associate this image ...” and “Do you or do you not associate this image ...” The question “Do you associate this image ... “ implies “or do you not” especially because the answer is yes, no, or don’t know and respondents have been instructed not to guess.

However, the question provides aided awareness because it asks a universe of people who have recently purchased a watch costing at least \$1,500 or who may purchase a watch costing that much whether they associate the crown design with a company that makes watches or jewelry. The question signals the company makes watches or jewelry. The results from an aided awareness question lack evidentiary value on the question of fame. *See ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1247 (TTAB 2015) (citing *Carefirst of Md., Inc. v. FirstHealth of*

⁷⁵ *Id.* at p. 13 (71 TTABVUE 20).

⁷⁶ *Id.* at p. 13 n.8 (71 TTABVUE 20).

⁷⁷ *Id.* at p. 13 (71 TTABVUE 20).

the Carolinas Inc., 77 USPQ2d 1492, 1507 (TTAB 2005) (declining to find a mark to be well-known and famous based upon aided awareness results from brand image studies)).

- Jay did not calculate the results correctly.⁷⁸ As discussed above, Jay took the test group results, 53% of the survey respondents associated the crown design with Opposer, and subtracted 4% of the control group who associated the star design with Opposer to reach at 49% recognition result. However, Applicant contends that Jay should have included another 34% of the control group who identified the fictitious star design with another company because they were guessing; they should not have associated the fictitious star design with any company that marks watches or jewelry.⁷⁹ According to Applicant is true recognition rate is 15% (53% - 38% = 15%). In essence, Applicant equates all the control group respondents who identified the fictitious star design with a company that makes watches and jewelry whether they identified Opposer or another company such as Movado, Tiffany, De Beers, etc. and considered the responses guessing or noise.⁸⁰

Seventy-nine percent of the test group respondents associated the crown design with a company or companies that make watches or jewelry. Thirty-eight percent of

⁷⁸ Applicant's Brief, pp. 13-14 (71 TTABVUE 20-21).

⁷⁹ *Id.* at p. 14 (71 TTABVUE 21). *See also* Hollander Testimony Decl. ¶39 (53 TTAVUE 12-13).

⁸⁰ Jay Rebuttal Survey Decl. ¶ 21 (62 TTABVUE 12).

the control group respondents associate the star design with a company or companies that make watches or jewelry.⁸¹

Fifty-three percent of the test group respondents who associated the crown design with a company or companies that make watches or jewelry identified Opposer as that company. Four percent of the control group respondents who associated the star design with a company or companies that make watches or jewelry identified Opposer as that company. The control group respondents that improperly associated Opposer with the star design is the appropriate guessing or noise factor for which we must account because it is the association of a crown design with Opposer that we are measuring.

Finally, we note that Opposer's universe is under-inclusive. As noted above, Opposer's survey respondents were people who have bought a watch that cost \$1,500 or more within the last two years or indicated that they would buy such a watch in the next 12 months.⁸² However, the description of goods in Opposer's pleaded registrations is "time pieces of all kinds and parts thereof" without any restrictions or limitations as to price. Because we are limited to determining the right to registration, not the right to use, we must base our analysis on the description the of goods and services set forth in Opposer's pleaded registration regardless of what the record may reveal as to the particular nature of Opposer's goods or services, channels of trade or class of purchasers. *Octocom Syst. Inc. v. Houston Comput. Svcs. Inc.*,

⁸¹ Jay Rebuttal Testimony Decl. ¶ 22 (62 TTABVUE 13).

⁸² Jay Testimony Decl. ¶ 8 (40 TTABVUE 4).

918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). *See also Stone Lion Capital Partners v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534-1535 (Fed. Cir. 1997); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000). By limiting the universe of survey respondents to consumers who have or will purchase a watch that costs at least \$1,500, Opposer has skewed the survey results to inflate the percentage of respondents who associate the crown design with Opposer.

Because Opposer's survey question presents an aided awareness test, the results may have been skewed by the use of different color combinations in the stimuli shown the test and control groups, and the survey universe was under-inclusive, we find that Opposer's 49% recognition rate is inflated. The survey results point to some commercial strength attached to the crown design but it falls short of clear proof of fame.

b. Other evidence of commercial strength/fame.

"Since the early 1940's, [Opposer] has also used the mark  ... as a source identifier for all things related to [Opposer]."⁸³ Opposer has continuously used the crown design on all of the watches it sells.⁸⁴ Over the past ten years, Opposer has sold over 100,000 watches annually ranging in price from \$5,000 to over \$100,000.⁸⁵

⁸³ Esposito Testimony Decl. ¶5 (46 TTABVUE 3).

⁸⁴ *Id.* at ¶7 (46 TTABVUE 4).

⁸⁵ *Id.*

Opposer sells its watches through a network of over 300 retailers throughout the United States. In most cases, these retailers also offer other watch brands and jewelry.⁸⁶ “[O]ver 80%” of Opposer’s retailers have point of sale display featuring a stand-alone crown design.⁸⁷

Opposer distributes promotional products featuring the crown design at events such as The Masters, the U.S. Open, and Rolex24 at Daytona.⁸⁸

[Opposer’s] advertising and promotion of its Rolex watches is extensive, prominent and since the early 1940’s always includes use of the Crown Design mark. Over the past 10 years, Rolex has spent over five hundred million dollars (\$500,000,000) promoting and advertising its watches in the United States.⁸⁹

Opposer also uses the advertising tagline “A Crown for Every Achievement” that highlights the crown design.⁹⁰

Opposer introduced seven articles posted on various Internet websites referring to the renown of Opposer’s crown design trademark.⁹¹ We list below excerpts from the seven Internet articles:⁹²

⁸⁶ *Id.* at ¶9 (46 TTABVUE 4).

⁸⁷ *Id.* at ¶10 (46 TTABVUE 5).

⁸⁸ *Id.* at ¶12 (46 TTABVUE 5).

⁸⁹ *Id.* at ¶14 (46 TTABVUE 6)

⁹⁰ *Id.* at ¶15 (46 TTABVUE 5)

⁹¹ 45 TTABVUE 67-242.

⁹² The articles posted at 45 TTABVUE 160-163, 164-172, 173-176, 177-187, 188-190, 191-206, 207-212, 213-221, 222-226, 227-232, 233-234, 235-236, and 237-242 do not expressly refer to the crown logo.

Likewise, the articles posted at 45 TTABVUE 255-260, 261-269, 270-284, and 285-289 do not expressly refer to the crown design.

- Millenary Watches website (millenarywatches.com).



Rolex Logo: The Complete History

Rolex is arguably the world's most iconic and recognized watch logos in the world.⁹³



The Rolex crown logo is definitely one of the most iconic and recognized watch logos in the world.

Dare we say that the Rolex crown logo is among the most recognized logos in the world? That would perhaps be stretching it a bit too far?

If you said not, think again. In fact, in terms of international widespread recognition, the Rolex crown logo ranks among the most iconic logos of all time, along with the logos of Apple, General Electric, Target, and Mercedes Benz.⁹⁴

⁹³ 45 TTABVUE 67-68.

⁹⁴ 45 TTABVUE 76-77.

To take it one step further, [Opposer] has also incorporated their logo into their slogan. That is, “A crown for every achievement.” People can relate to this as it is common that people buy Rolex watches, and luxury watches, in general, to commemorate and celebrate their achievements in life.⁹⁵

- Spot the Watch website (sportthewatch.com)

Rolex is considered the king of the watch world. The crowning jewel to every timepiece they make showcases the instantly recognizable crown logo upon its dial. The symbol is synonymous with luxury, performance, and quality. The logo is also engraved on the bracelet and etched into the surface of every watch’s crown.⁹⁶

All that Rolex reveals about the logo is a message that underpins their entire portfolio of masterpieces – “A Crown For Every Achievement.” And who can argue with that? Every special occasion in life warrants a Rolex watch. As well as a name that’s easy to remember, the unmistakable crown logo is both distinguishable and memorable – a fine example of a prestigious brand that utilizes its marketing to the max.⁹⁷

- The Watch Company Blog (thewatchcompany.com) (November 8, 2019)



One of the most recognizable and successful trademarks in the world is the Rolex logo – the iconic Rolex crown. In fact,

⁹⁵ 45 TTABVUE 79.

⁹⁶ 45 TTABVUE 88.

⁹⁷ 45 TTABVUE 91.

the Rolex logo is sometimes the sole reason some people purchase a Rolex watch. It's THAT famous and the branding is THAT good that it draws people to spend thousands of dollars just to own a piece of it.⁹⁸

—

No matter the reason, one thing is clear, the Rolex logo represents something that almost everyone wants to own.⁹⁹

—

Some attribute wearing a Rolex watch akin to wearing a crown – they feel honoured and privileged. Some claim that Rolex is the “King of all Watches” – which many can only agree.¹⁰⁰

—

Ranking among the most iconic and recognizable logos of all time, the Rolex crown sits on top along with Mercedes Benz, Apple and General Electric logos. And rightfully so, because almost everybody, even the non-watch aficionado, recognizes the Rolex logo.¹⁰¹

- Money Inc. website (moneyinc.com)

102

The History of and Story Behind the Iconic Rolex Logo

by Garrett Parker 3 Months Ago



⁹⁸ 45 TTABVUE 100.

⁹⁹ 45 TTABVUE 101.

¹⁰⁰ 45 TTABVUE 108.

¹⁰¹ 45 TTABVUE 113.

¹⁰² 45 TTABVUE 123.

Let's delve into how Rolex came to be and the reasons behind the iconic crown.¹⁰³

- Xupes Journal (xupes.com) (July 16, 2018)



THE ROLEX CORONET: A BRIEF HISTORY

When it comes to the world of fine timepieces, there's really only one logo which has broken through the industry to become an internationally recognised symbol, known and beloved even by those who perhaps have little interest in luxury watches. We are, of course, talking about the iconic Rolex coronet: a brand which has already endured for a hundred years, and has in that time become the single most recognised and appreciated watch company in the world.¹⁰⁴

- Bob's Rolex Blog (Bobswatches.com) (April 23, 2013)

THE HISTORY OF THE ROLEX LOGO IS "EXQUISITE"¹⁰⁵



¹⁰³ 45 TTABVUE 125.

¹⁰⁴ 45 TTABVUE 134-135.

¹⁰⁵ 45 TTABVUE 147.

All theories aside, the crown perfectly encapsulates Rolex's core values of excellence and exclusivity, while its five points mirror the five letters of the company name that are frequently printed below it. Additionally, the coronet shape inherently carries with it connotations of honor and prestige, while also complimenting the company's slogan, "A crown for Every Achievement."¹⁰⁶

- The Tru Facet website (trufacet.com) (February 12, 2015)

The Story Behind the Logo

Here are the stories behind the famous and iconic logos of the luxury powerhouses in fashion, jewelry and watchmaking: Chanel, Hermès, Rolex, and Longines.¹⁰⁷



Wilsdorf and Davis trademarked the Rolex logo in 1925. The original design was a five-pointed coronet or crown in gold above Rolex in green text with a gold outline. The logo embodied the Rolex slogan, "A crown for Every Achievement" and the chosen colors were meant to symbolize the brand's excellence in watchmaking (gold) and prosperity (green).¹⁰⁸

¹⁰⁶ 45 TTABVUE 149.

¹⁰⁷ *Id.* at 153.

¹⁰⁸ *Id.* at 155.

Opposer introduced excerpts from the Rolex Forum (rolexforums.com)¹⁰⁹ which feature two postings from people from the United States referring to the crown logo.¹¹⁰

c. The number and nature of similar marks in use in use on similar goods and services.

Under the sixth *DuPont* factor, we consider “[t]he number and nature of similar marks in use on similar goods.” *DuPont*, 177 USPQ at 567. “If the evidence establishes that the consuming public is exposed to third-party use of similar marks on or in connection with similar goods . . . , this evidence ‘is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.’” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005).

Applicant introduced Internet evidence showing third parties using crown designs in connection with jewelry, watches and retail stores to prove the public is accustomed to seeing similar marks used on similar goods and services.¹¹¹ In the context of determining market or commercial strength, “[t]he probative value of third-party trademarks depends entirely upon their usage.” *Palm Bay*, 73 USPQ2d at

¹⁰⁹ *Id.* at 244-253.

¹¹⁰ *Id.* at 244 (“I think that from many your comment is spot on, it’s the five pointed crown or nothing) (from the U.K.), 245 (“Many many congratulations on reaching that big milestone of 50 and getting your first Rolex. I waited until 58 before getting my first watch from the five pointed crown.”) (from the U.K.), 246 (So we were visiting a far away [sic] town today and I saw the golden coronet and thought I’d try my luck.) (from the U.K.), 251 (“I’ve not yet lost faith in the mighty crown.”) (from Spain), 252 (“Some people would rather eat s - - t, then wear a watch other than the almighty crown.”) (Virginia), 253 (“Puts a lot of Swiss brands to shame, including the famous crown.”) (USA).

¹¹¹ 56 TTABVUE.

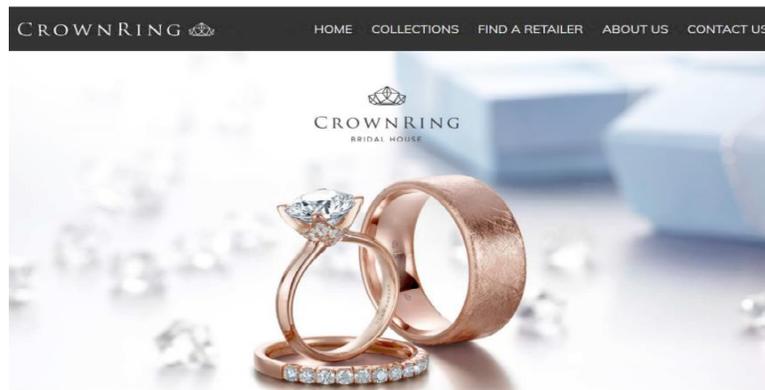
1693.” Third-party use of similar marks with similar goods or services may curtail the commercial strength of a mark. *Jack Wolfskin Austrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129 (Fed. Cir. 2015); *Juice Generation*, 115 USPQ2d at 1674-75.

Applicant introduced one third-party website displaying a crown design on watches: the Maserati website (maseratistore.com/us).¹¹² We reproduce below a photograph of the Maserati watch.



Opposer introduced two third-party websites displaying a crown for jewelry.

- Crown Ring (crownring.com). We reproduce an excerpt from the Crown Ring website below.¹¹³



¹¹² 56 TTABVIE 59.

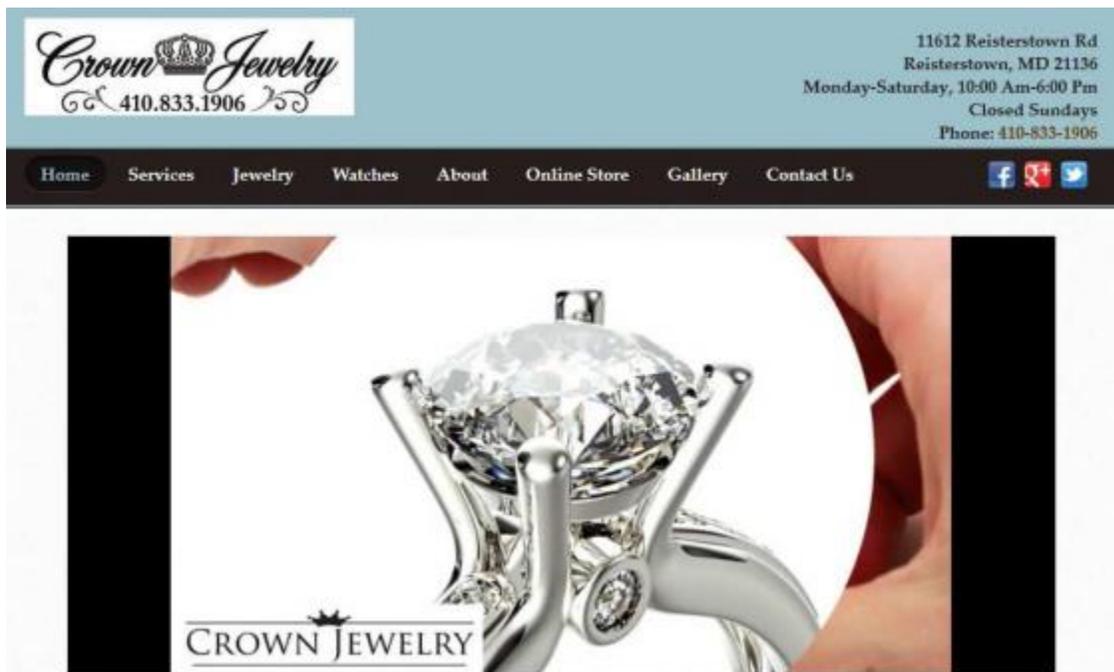
¹¹³ *Id.* at 39-40.

- Trafari Vintage Jewelry (ebay.com/gds/Trifari-Jewelry-Identification-and-Marks). We reproduce below an excerpt from the Trafari Vintage Jewelry website.¹¹⁴



Opposer introduced five third-party crown designs used in connection with retail jewelry stores services.

- Crown Jewelry (crownjewelryrepairs.com). We reproduce below an excerpt from the Crown Jewelry website.¹¹⁵



¹¹⁴ *Id.* at 71-76.

¹¹⁵ *Id.* at 10.

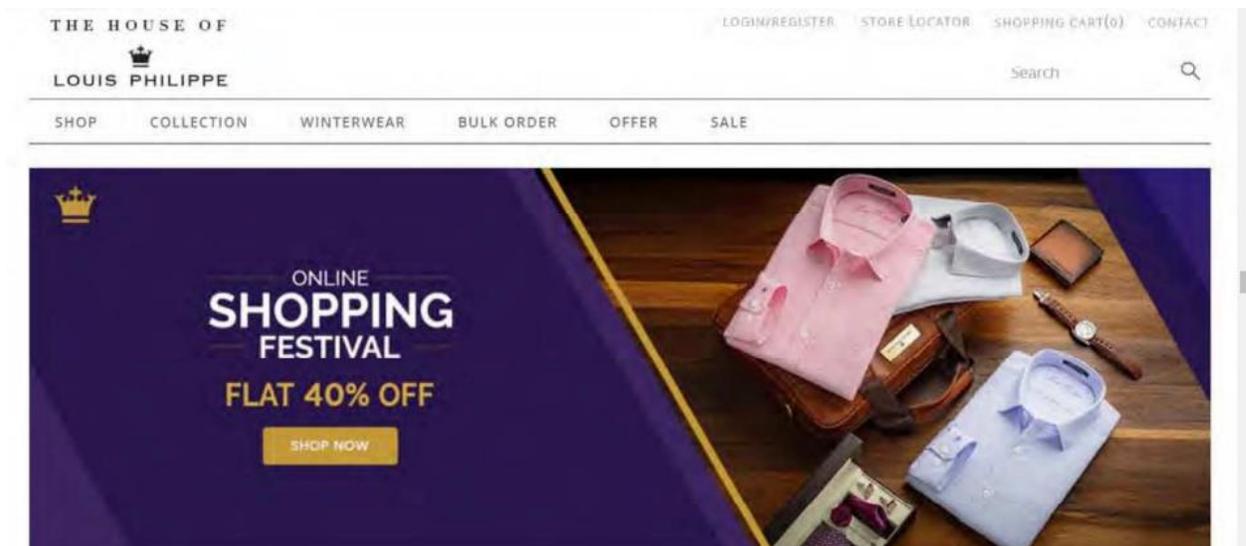
- Crown Jewelry (crownjewelry.com). We reproduce an excerpt from the Crown Jewelry website.¹¹⁶

Free shipping and returns
FANCY UP, BOHO BEAUTIES. 30% OFF >

C R O W N

SHOP ABOUT BLOG MY ACCOUNT CART

- The House of Louis Philippe (louisphilippe.com). We reproduce below an excerpt from The House of Louis Philippe website.¹¹⁷



- Under the Crown (underthecrown.com). We reproduce below an excerpt from the Under the Crown website.¹¹⁸

¹¹⁶ *Id.* at 13.

¹¹⁷ *Id.* at 52. The House of Louis Philippe does not use the crown design on its watches. 56 TTABVUE 55.

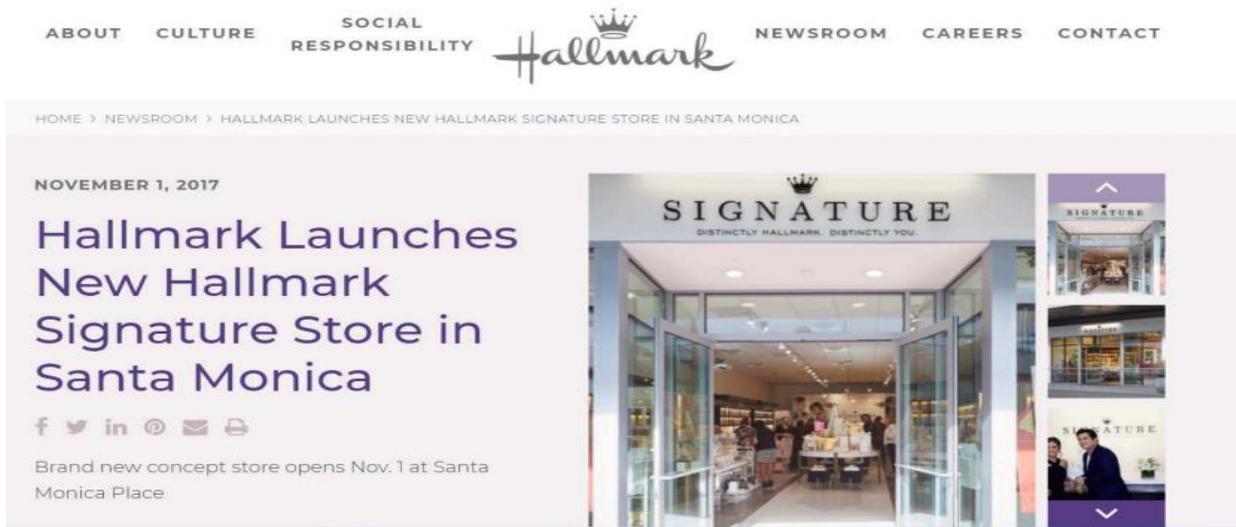
¹¹⁸ 56 TTABVUE 77. Applicant introduced a copy of Registration No. 3663143 for the mark UNDER THE SUN and a crown design for “estate jewelry,” in International Class 14, at 57 TTABVUE 345.



- Two Hallmark webpages displaying crown designs. We reproduce below the Hallmark and crown composite mark posted at <hallmark.com>. ¹¹⁹



We reproduce below the Hallmark and crown mark for the Signature store (corporate.hallmark.com). ¹²⁰



¹¹⁹ 56 TTABVUE 86.

¹²⁰ *Id.* at 105.

With the exception of the Trafari crown, all of the other third parties use their crown designs in close conjunction with a word mark. In other words, the third parties do not use the crown designs as a stand-alone mark. With the exception of the Hallmark crown, none of the other crowns resemble Opposer's crown. The third-party use of crown designs is not so extensive as to significantly weaken the commercial strength of Opposer's crown design for watches.

d. Conclusion

We face a record on which Opposer joins substantially every reference to the crown design with the ROLEX word mark. For example, four of the seven Internet articles Opposer introduced to show the fame of the crown design feature the composite mark ROLEX and the crown design. In addition, the Internet articles Opposer introduced from the Forbes Magazine website (forbes.com) regarding "World's Most Valuable Brands" refer to ROLEX¹²¹ or the ROLEX and crown design composite mark.¹²² On this record, the coupling of the word mark and design mark does not give consumers a chance to disassociate the word mark ROLEX from the crown design. *Cf. Bose Corp.*, 63 USPQ2d at 1307 ("The distinction between uniform coupling of the famous house mark with the product marks and communication to consumers that typically gives significant independent reference to the product apart from the house mark is important, because in the latter instance the consumer has a basis on which to disassociate the product mark from the house mark.").

¹²¹ 49 TTABVUE 23, 58, 77-78, 96, and 115.

¹²² *Id.* at 39, 134, 153, and 169.

While the record is not sufficient to support finding the crown design is a famous mark, we find the crown design falls on very strong side “along a spectrum of from very strong to very weak.” *Joseph Phelps Vineyards*, 122 USPQ2d at 1734. In sum, Opposer’s crown design is an inherently distinctive and commercially strong mark that is entitled to a broad scope of protection.

B. Similarity or dissimilarity of the marks.

We now turn to the *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012). We

keep in mind that “[s]imilarity is not a binary factor but is a matter of degree.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003)).

The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Because the description of goods and services in Opposer’s pleaded registrations are “time pieces of all kinds and parts thereof” and “retail store services featuring watches, timepieces, clocks and jewelry” without any limitations or restrictions as to price, channels of trade and classes of consumers and Applicant’s description of goods and services are for cosmetic, carrying cases for electronics, traveling bags, clothing, and retail store services for those goods without any limitations or restrictions as to price, channels of trade and classes of consumers, the average purchaser is an ordinary consumer.

We reproduce below marks of the parties:

Applicant’s Mark



Opposer’s Mark



“[W]here the question of likelihood of confusion to be decided involves design marks which are not capable of being spoken, the question of the similarity of the marks must be determined primarily on the basis of their visually similarity.” *In re Vienna Sausage Mfg. Co.*, 16 USPQ2d 2044, 2047 (TTAB 1990). When we place the marks side-by-side as displayed above, we can detect specific differences. However, those differences are minimal. In addition, when consumers see the marks at different times on similar goods or services, the recollection of the mark first viewed will be a general impression most likely devoid of any details serving to distinguish the marks. What consumers will remember is a crown with five points with circles on the points.

We find the marks are similar in appearance, meaning and commercial impression.

C. Similarity or dissimilarity and nature of the goods and services.

In determining whether the goods and services are related, it is not necessary that the goods and services of the parties be similar or competitive in character to support a holding of likelihood of confusion; it is sufficient for such purposes that a party claiming damage establish that the goods and services are related in some manner or that conditions and activities surrounding marketing of the goods and services are such that they would or could be encountered by same persons under circumstances that could, because of similarities of marks used with them, give rise to the mistaken belief that they originate from or are in some way associated with the same producer.

Coach Servs., 101 USPQ2d at 1722; *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1410 (TTAB 2010).

The issue is not whether purchasers would confuse the parties' goods or services, but rather whether there is a likelihood of confusion as to the source of these goods or services. *See Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); *In re I-Coat Co., LLC*, 126 USPQ2d 1730, 1737 (TTAB 2018) (“the test is not whether consumers would be likely to confuse these goods, but rather whether they would be likely to be confused as to their source.”).

Under this *DuPont* factor, Opposer need not prove, and we need not find, similarity as to each product or service listed in the description of goods and services. It is sufficient for a refusal based on likelihood of confusion that we find any item encompassed by the identification of goods in a particular class in the application and registration related. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *General Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1588 n.1 (TTAB 2011), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014).

To show that Opposer's watches are related to Applicant's goods, Opposer introduced excerpts from eight third-party websites showing the third parties using the same mark to identify all of the following: watches, clothing (Class 25), wallets

and travel bags (Class 18), sunglasses (Class 9), and perfume, eau de toilette and deodorant (Class 3).¹²³ Third-party webpage evidence showing the same mark used for goods and services offered by both parties is probative to demonstrate the relatedness of Applicant's goods and Opposer's goods and services for likelihood of confusion purposes. *See, e.g., In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (relatedness supported by evidence that third parties sell both types of goods under same mark, showing that "consumers are accustomed to seeing a single mark associated with a source that sells both."); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002) (evidence that consumers encounter one mark designating a single source for the services of both parties supports a finding that the services are related); *In re Embiid*, 2021 USPQ2d 577, at *22-23 (TTAB 2021) (citing *Ox Paperboard*, 2020 USPQ2d 10878, at *5; and *Hewlett-Packard*, 62 USPQ2d at 1004); *In re Integrated Embedded*, 120 USPQ2d 1504, 1514-15 (TTAB 2016) (websites made of record by examining attorney "demonstrate[d] that services of the type offered by both Applicant . . . and Registrant are marketed and sold together online under the same marks" and "[s]uch evidence is sufficient to find that the services at issue are related."); *In re Anderson*, 101 USPQ2d 1912, 1920 (TTAB 2012) (Internet excerpts from "several third-party car dealerships offering 'tires' for sale on their websites" was "evidence that consumers expect to find both 'tires,' . . . "and 'automobiles' . . . emanating from a

¹²³ 43 TTABVUE 7-198.

common source.”); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009) (accepting website evidence to show relatedness of the goods).

In addition, as discussed above, Applicant introduced copies of third party registrations featuring crown designs to show that crown designs are inherently weak marks.¹²⁴ Some of those registrations are relevant to the extent that they include descriptions of goods in both Opposer’s pleaded registrations and Applicant’s application.¹²⁵ Third-party registrations based on use in commerce (or registrations based on Section 44 or 66 that are over five years old and have declarations of use) that individually cover a number of different goods or services may have probative value to the extent that they serve to suggest that the listed goods or services are of a type that may emanate from the same source. *In re Country Oven, Inc.*, 2019 USPQ2d 443903, *8 (TTAB 2019); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff’d mem.* 864 F.2d 149 (Fed. Cir. 1988). For example,

- Registration No. 5498107 for the mark JON DOTTA and design,¹²⁶ Registration No. 5930496 for the mark FIN DES TEMPS and design,¹²⁷ and Registration No.

¹²⁴ 57 TTABVUE 2 and 7-130.

¹²⁵ See Trademark Rule 2.122(a), 37 C.F.R. § 2.122(a) (“When evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.”).

Applicant submitted eight third-party registrations for watches and clothing (Class 25), two third-party registrations for watches and eye glasses (Class 9), and three third-party registrations for watches and products in Class 18.

¹²⁶ 57 TTABVUE 67.

¹²⁷ 57 TTABVUE 47.

5458327 for the mark RA and design,¹²⁸ and Registration No. 3241627 for the mark MONICA MOSS and design¹²⁹ are registered for, inter alia, watches and clothing (Class 25);

- Registration No. 3241627 for the mark MONICA MOSS and design is registered for, inter alia, watches and travel bags, athletic bags, and wallets (Class 18);¹³⁰ and
- Registration No. 4468116 for the mark RAFELLO & CO. and design for, inter alia, watches and eye glasses (Class 9).¹³¹

To further support the relatedness of Opposer's watches with Applicant's goods, Opposer introduced evidence showing Opposer's watches in advertisements and news articles alongside other luxury items like various types of clothing, sunglasses, cologne, and leather goods encompassing Applicant's goods¹³² to show that Opposer's watches and Applicant's goods are all luxury fashion brands and, thus, related products.¹³³ In this regard, Opposer distributes promotional products displaying the crown design, including clothing (Class 25), leather wallets, travel bags and cardholders (Class 18), sunglasses (Class 9), cologne (Class 3).¹³⁴ Opposer uses the crown design on this collateral merchandise used to promote sales of Opposer's

¹²⁸ 57 TTABVUE 106.

¹²⁹ 57 TTABVUE 84.

¹³⁰ 57 TTABVUE 84.

¹³¹ 57 TTABVUE 104.

¹³² Esposito Testimony Decl. Exhibit 15 (47 TTABVUE 7, 13, 24, 55, 57, 58, 64, 83, 92, 98, 104, 105, and 106).

¹³³ Hansen Testimony Decl. ¶5 (58 TTABVUE 3) (Applicant sells a wide range of men's fashion brands, including through its JUNK DE LUXE and crown design trademark).

¹³⁴ Esposito Testimony Decl. ¶12 and Exhibit 8 (46 TTABVUE 5 and 226-419).

watches. See *L.C. Licensing, Inc. v. Berman*, 86 USPQ2d 1883, 1889 (TTAB 2008) (“It is common knowledge, and a fact of which we take judicial notice, that the licensing of commercial trademarks on ‘collateral products’ has become a part of everyday life.”) *Chi. Bears Football Club, Inc. v. 12th Man Tenn. LLC*, 83 USPQ2d 1073, 1075-76 (TTAB 2007) (opposers showed common law rights in marks of the Chicago Bears professional football team used “on various items including [beach towels and bath towels] that are similar or identical to items for which applicant seeks registration,” including “towels” in Class 24); *Turner Entm’t Corp. v. Nelson*, 38 USPQ2d 1942, 1945 (TTAB 1996) (“It is common knowledge, and in the present case, undisputed that video games, t-shirts, beach towels, caps and other logo-imprinted products are used as promotional items for a diverse range of goods and services.”).

Applicant argues that because Applicant filed its application based on Section 66 of the Trademark Act, Opposer is limited to the grounds identified in the ESTTA cover sheet (i.e., Opposer’s pleaded registrations).¹³⁵ Thus, Opposer may not rely on any common law rights for any other goods or services.¹³⁶ Nevertheless, Opposer alleges, “For over 50 years [Opposer] has consistently used the Crown Design trademark in its advertisements, promotional materials and all of its sponsorship events.”¹³⁷ We consider Opposer’s use of its crown design on promotional items solely for purposes of analyzing the relatedness of Opposer’s watches and retail store

¹³⁵ Applicant’s Brief, pp. 6-7 (71 TTABVUE 13-14) (citing *Destileria Serralles Inc. v. Kabushiki Kaisha Donq DBA Donq Co., Ltd.*, 125 USPQ.2d 1463, 1465-1467 (TTAB 2017); *CSC Holdings, LLC v. SAS Optimhome*, 99 USPQ.2d 1959 (TTAB 2011)).

¹³⁶ Applicant’s Brief, pp. 7 (71 TTABVUE 14).

¹³⁷ Notice of Opposition ¶5 (1 TTABVUE 6).

services featuring watches and jewelry with Applicant's goods and services. To be clear, we do not consider any trademark rights that Opposer may have in its Crown Design as a source identifier for these goods, but view this evidence as relevant because it shows the types of promotional products that Opposer may distribute in connection with its watches and retail watch store services.¹³⁸

We reproduce below representative examples of Opposer's promotional products.

139



140



¹³⁸ This is different than *Destileria Serralles, Inc. v. Kabusiki Kaisha Donq DBA Donq Co. Ltd.*, 125 USPQ2d 1463, 1466-67 (TTAB 2017), where opposer sought to amend its notice of opposition to an application based on Section 66 to include common law rights as part of its likelihood of confusion claim beyond those opposer initially pleaded. Here, we are not seeking to add common law rights to Opposer's likelihood of confusion claim; rather, we are using the evidence to show that Opposer's watches and Applicant's goods are related products.

¹³⁹ Esposito Testimony Decl. Exhibit 8 (46 TTABVUE 229) (leather key ring).

¹⁴⁰ Esposito Testimony Decl. Exhibit 8 (46 TTABVUE 245) (leather bag).



142



143



¹⁴¹ Esposito Testimony Decl. Exhibit 8 (46 TTABVUE 262 and 293) (sunglasses and case).

¹⁴² *Id.* (46 TTABVUE 340) (perfume).

¹⁴³ *Id.* (46 TTABVUE 360) (hat).



Considering the strength of Opposer’s crown design, the close similarity of the marks, and Opposer’s use of its crown design on promotional products that fall within Applicant’s description of goods, the above noted evidence proves consumers are likely to believe that the source of Applicant’s products in Classes 3, 9, 18 and 25 emanate from or are somehow associated with or sponsored by Opposer.

With respect to Applicant’s description of services, Applicant’s “wholesale and retail store services, including via the Internet,” featuring all the goods listed in Applicant’s Class 3, 9, 18 and 25 description of goods is so broad that it is similar to a department store. The MERRIAM-WEBSTER DICTIONARY (merriam-webster.com) (accessed November 18, 2021) defines as department store as “a store having separate sections for a wide variety of products.”¹⁴⁵ Watches and jewelry are just be two more

¹⁴⁴ Esposito Testimony Decl. Exhibit 8 (46 TTABVUE 385) (tie).

¹⁴⁵ The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1104 n.9 (TTAB 2018); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

products that may be included in the broad array of products such that consumers will not perceive those products are emanating from a different source.

The five third-party registrations listed below support that point (emphasis added):

- Registration No. 3480998 for the mark CHANTECLER and design for “the bringing together, for the benefit of others, a variety of goods, namely, bracelets, brooches, chains, medallions, necklaces, pearls, precious stones, rings, **watches** and clocks, dishes of precious metal, cufflinks, jewelry cases not of metal, picture frames not of metal, painted glassware, porcelain ware, all of which enable customers to conveniently view and purchase those goods; electronic commerce services, namely, providing information about the foregoing goods via telecommunication networks for advertising and sales purposes;”¹⁴⁶

- Registration No. 5825356 for the mark GOLD & BEYOND for “on-line consignment services whereby goods are received on consignment in online retail stores featuring handbags, watches, footwear, **jewelry**, clothing, accessories; on-line retail consignment stores featuring handbags, **watches**, footwear, **jewelry**, clothing, accessories; retail consignment stores featuring handbags, **watches**, footwear, jewelry, clothing, accessories; retail consignment stores in the field of handbags, **watches**, footwear, **jewelry**, clothing, accessories;”¹⁴⁷

¹⁴⁶ 57 TTABVUE 28.

¹⁴⁷ 57 TTABVUE 55.

- Registration No. 6129327 for the mark KK and design for, inter alia, online wholesale and retail store services in featuring clothing, electronics, **jewelry** and a wide variety of consumer goods;¹⁴⁸
- Registration. No. 6240519 for the mark G GRIMAL and design for clothing and retail jewelry store services;¹⁴⁹ and
- Registration. No. 5849508 for the mark Q (stylized) for online retail store services featuring jewelry and clothing.¹⁵⁰

In addition, the excerpts from eight third-party websites showing the third parties using the same mark to identify watches, clothing (Class 25), wallets and travel bags (Class 18), sunglasses (Class 9), and perfume, eau de toilette and deodorant (Class 3)¹⁵¹ we discussed above also shows online retail store services offering the sale of all those products.

We find that Applicant's "wholesale and retail store services, including via the Internet," featuring all the goods listed in Applicant's Class 3, 9, 18 and 25 description of goods is related to Opposer's "retail store services featuring watches, timepieces, clocks and jewelry."

¹⁴⁸ 57 TTABVUE 71.

¹⁴⁹ 57 TTABVUE 53.

¹⁵⁰ 57 TTABVUE 98.

¹⁵¹ 43 TTABVUE 7-198.

D. Established, likely-to-continue channels of trade and classes of consumers.

The excerpts from eight third-party websites showing the third parties using the same mark to identify watches, clothing (Class 25), wallets and travel bags (Class 18), sunglasses (Class 9), and perfume, eau de toilette and deodorant (Class 3) we discussed above also shows these products are offered for sale through the same channels of trade (i.e., designers' websites).¹⁵²

In addition, Opposer introduced excerpts from Macy's website (macys.com) showing the retailer offering to sell watches, including Opposer's watches, leather bags and wallets, perfume, sunglasses, and clothing.¹⁵³ See also excerpts from the Bloomingdale's website (bloomingdales.com),¹⁵⁴ the Farfetch website (farfetch.com),¹⁵⁵ Zumiez website (zumiez.com),¹⁵⁶ Culture Kings website (culturekings.com),¹⁵⁷ and Explicit Streetwear website (explicitstreetwear.com).¹⁵⁸

Third parties offer the goods and services in Applicant's description of goods and services in the same channels of trade as the watches and retail store services in Opposer's descriptions of goods and services. This *DuPont* factor weighs in favor of finding a likelihood of confusion.

¹⁵² 43 TTABVUE 7-198.

¹⁵³ 44 TTABVUE 203-243.

¹⁵⁴ 44 TTABVUE 244-282.

¹⁵⁵ 64 TTABVUE 46-107.

¹⁵⁶ 64 TTABVUE 108-118.

¹⁵⁷ 64 TTABVUE 119-143.

¹⁵⁸ 64 TTABVUE 144-148.

E. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.

Neither party is aware any reported instances of actual confusion.¹⁵⁹ However, the absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by Respondent of its mark for a significant period of time in the same markets as those served by Petitioner under its mark. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992) (“[E]vidence thereof is notoriously difficult to come by and, in any event, the test under Section 2(d) of the Trademark Act is likelihood of confusion rather than actual confusion.”). In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to occur. *Barbara’s Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred); *Red Carpet Corp. v. Johnstown Am. Enters. Inc.*, 7 USPQ2d 1404, 1406-1407 (TTAB 1988); *Central Soya Co., Inc. v. N. Am. Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) (“[T]he absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring.”).

¹⁵⁹ Opposer’s response to Applicant’s requests for admission Nos. 11 and 12 (52 TTABVUE 33-34); Hansen Testimony Decl. ¶16 (58 TTABVUE 17).

The eighth *DuPont* factor — “[t]he length of time during and conditions under which there has been concurrent use without evidence of actual confusion,” *DuPont*, 177 USPQ at 567, is unlike other *DuPont* factors because it requires us to look at actual market conditions, to the extent there is evidence of such conditions of record, and not merely the identifications of goods and services in the involved application and registrations.¹⁶⁰ In this regard, we consider all of the evidence of record that may be relevant to the eighth *DuPont* factor. *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, at *6 (TTAB 2020).

In February 2016, Applicant began distributing and selling clothing and other products under its JUNK DE LUXE and crown design mark reproduced below:¹⁶¹



Such use of the crown design features the composite mark, not the crown design as a stand-alone mark.¹⁶²

In the five years since Applicant began using the composite mark, it has made minimal sales on the wholesale level.¹⁶³ Applicant anticipates sales on the retail

¹⁶⁰ As discussed, *supra*, the second, third, and fourth *DuPont* factors, discussing the similarity or dissimilarity of the goods and services, channels of trade, and relevant consumers, involve analyses based on the identifications as set forth in the application and the cited registration. *See Stone Lion*, 110 USPQ2d at 1162. As such, we may not consider, in assessing these *DuPont* factors, evidence of how Opposer and Applicant are actually selling the goods and services in the marketplace. *Id.*

¹⁶¹ Hansen Testimony Decl. ¶14 (58 TTABVUE 7).

¹⁶² Hansen Testimony Decl. ¶9 and Exhibits 9-16 (58 TTABVUE 4 and 21-120).

¹⁶³ Hansen Testimony Decl. ¶14 (59 TTABVUE 7). Applicant designated its sales figures confidential. Accordingly, we refer to them in general terms. We disagree with Applicant's

numbers are greater than the wholesale numbers.¹⁶⁴ “Applicant’s products are distributed in the U.S. by Lindbergh and Shine LLC, Boca Raton, Florida.¹⁶⁵ Lindbergh and Shine has outlets in Atlanta, Las Vegas, Chesterfield, Missouri, Daytona Beach and Kapolei, Hawaii.¹⁶⁶

Applicant advertises through semi-annual catalogs, online advertising, and social media.¹⁶⁷ Social media include Facebook, Google.com, YouTube.com, and Instagram.¹⁶⁸ Applicant did not testify or provide any other evidence regarding the traffic it receives from its social media, nor did Applicant testify or provide any other evidence regarding how many catalogs it distributed and to whom.

Based on the testimony and evidence, there has not been a reasonable opportunity for confusion to occur. Accordingly, the lack of any reported instances of actual confusion is a neutral *DuPont* factor.

F. Conclusion.

Because the marks are similar, the goods and services are related and are offered in the same or similar channels of trade, we find that Applicant’s crown design mark



for the goods identified in Classes 3, 9, 18, and 25 and the services identified

contention that its U.S. sales are substantial. Applicant’s Brief, p. 36 (71 TTABVUE 43). The evidence does not support Applicant’s contention.

¹⁶⁴ *Id.* at 58 TTABVUE 7.

¹⁶⁵ Applicant’s response to Opposer’s interrogatory No. 13 (41 TTABVUE 10).

¹⁶⁶ Applicant’s response to Opposer’s interrogatory No. 28 (41 TTABVUE 20-21).

¹⁶⁷ Hansen Testimony Decl. ¶15 (58 TTABVUE 7)

¹⁶⁸ Applicant’s response to Opposer’s interrogatory No. 14 (41 TTABVUE 10-11).

in Class 35 is likely to cause confusion with Opposer's registered crown design  for "time pieces of all kinds and parts thereof" and "retail store services featuring watches, timepieces, clocks and jewelry."

VI. Laches

In an opposition proceeding, laches begins to run when the USPTO publishes the application for opposition. *See Nat'l Cable Television Ass'n v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1431 (Fed. Cir. 1991).

We conclude that there is no precedent which requires us to determine laches in an opposition or cancellation proceeding under a standard based on the time running from knowledge of use rather than knowledge of the application for registration. To clarify the law, we reject the Board's standard definitively now and reaffirm the position taken in *James Burroughs v. LaJoie*, [426 F.2d 570, 174 USPQ 339 (CCPA 1972)] which addresses the precise issue.

Logically, laches begins to run from the time action could be taken against the acquisition by another of a set of rights to which objection is later made. In an opposition or cancellation proceeding the objection is to the rights which flow from registration of the mark. ...

Thus, in this case laches, with respect to protesting the issuance of the registration for the mark, could not possibly start to run prior to October 16, 1984, when Cable's application for registration was published for opposition.

19 USPQ2d at 1431-32. *See also Panda Travel, Inc. v. Resort Option Enters., Inc.*, 94 USPQ2d 1789, 1797 (TTAB 2009) (laches begins to run when the mark is published for opposition. Because opposer timely filed after the mark was published for opposition, there can be no laches defense even assuming that opposer knew of applicant for 20 years.); *DAK Indus., Inc. v. Daiichi Kosho Co.*, 25 USPQ2d 1622

(TTAB 1992) (The Federal Circuit’s ACE Awards case makes “it clear that in an opposition proceeding, laches cannot begin to run until the mark is published for opposition. ... The Court could not have been clearer: the period which we consider in determining whether a plaintiff delayed in bringing an [opposition] action before the Board begins with the publication of the mark in the Official Gazette. Before then, no opposition is possible.” Defenses of laches, estoppel and acquiescence were dismissed on summary judgment.).

However, laches may be available if the applicant owns a prior registration for substantially the same mark and goods. *See Aquion Partners Ltd. P’ship v. Envirogard Prods. Ltd.*, 43 USPQ2d 1371, 1373 (TTAB 1997) (“[A] laches defense in an opposition proceeding may be based upon an opposer’s failure to object to an applicant’s earlier registration of substantially the same mark for substantially the same goods.”). *See also Brooklyn Brewery Corp., v. Brooklyn Brew Shop, LLC*, 2020 USPQ2d 10914, at *8 (TTAB 2020) (same). In this regard, Applicant claimed ownership of Registration No. 5061562 for the composite mark JUNK DE LUXE and a crown design, reproduced below, for the same description of goods and services in the application at issue:¹⁶⁹



Applicant’s registered composite mark JUNK DE LUXE and the crown design is not substantially the same mark as Applicant’s crown design mark at issue in this

¹⁶⁹ Hansen Testimony Decl. ¶13 and Exhibit 21 (58 TTABVUE 4 and 138).

proceeding. *See Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes, Inc.*, 971 F.2d 732, 23 USPQ2d 1701, 1703-04 (Fed. Cir. 1992) (laches affirmative defense fails in part because applicant's prior registered Lincoln mark with a profile of Abraham Lincoln is not the same mark as applicant's Lincoln mark).

We dismiss Applicant's laches affirmative defense.

Decision: We sustain the opposition.